



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

Address: COMMISSIONER FOR PATENTS

P.O. Box 1450

Alexandria, Virginia 22313-1450

www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/822,674	04/13/2004	Hiroshi Morikawa	251708US-2 CONT	2872
22850	7590	08/08/2008		
OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314				
EXAMINER				
LUU, SYD				
ART UNIT		PAPER NUMBER		
2174				
NOTIFICATION DATE		DELIVERY MODE		
08/08/2008		ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patentdocket@oblon.com

oblonpat@oblon.com

jgardner@oblon.com

### Office Action Summary

**Application No.**

10/822,674

**Applicant(s)**

MORIKAWA, HIROSHI

**Examiner**

Sy D. Luu

**Art Unit**

2174

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 11 March 2008.  
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-36 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1-36 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
10) ☒ The drawing(s) filed on 13 April 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some \* c) ☐ None of:  
1. ☒ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☐ Information Disclosure Statement(s) (PTO/5508)  
Paper No(s)/Mail Date \_\_\_\_\_

- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_  
5) ☐ Notice of Informal Patent Application  
6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

1. This communication is responsive to the Amendment, filed March 11, 2008.
2. Claims 1-36 are pending in this application. Claims 1, 5, 7, 11, 19, 24, 29, and 33 are independent claims. This action is made Final.

#### *Claim Rejections - 35 USC § 103*

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. 1-2, 7-8, 13-18, 29-31 and 33-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wilson et al. ("Wilson", US 5,467,170) in view of Taguchi et al. ("Taguchi", US 5,937,232).

As per claim 1, Wilson teaches a method of controlling an image forming apparatus comprising the steps of:

displaying an operation status message area on a first part of a display (fig. 3; e.g. *message area showing "Ready to Copy"*);

displaying a document counting area configured to show a number of sheets set and a number of documents produced on a second part of the touch panel display (col. 4, lines 29-33);

displaying an input document handling area on a third part of the display, (fig. 3; col. 4, lines 51-58; *the area within the Job Setup Display JSUD shown above the job feature buttons "Original -> Copy" through "Zoom"*).

Wilson does not teach: (a) the display to be a touch panel display; and (b) allowing selection of at least one kind of input document for image forming from the input document handling area. However, these features are known in the art. For instance, Taguchi teaches a method of controlling an image forming apparatus, wherein a touch panel display is employed, as well as providing users with an input document handling area in which selection of a kind of input document from the input document handling area could be made (fig. 5; col. 12, lines 7-26; *e.g. color modes and character/image selections*). It would have been obvious to an artisan at the time of the invention to combine Taguchi's teaching with Wilson's method in order to further provide users with yet another choice for inputting selections, as well as to further enhance the image capturing resolution/quality/mode with specific functionalities for selecting type of input document.

As per claim 2, Wilson teaches the step of displaying an output document handling area on a fourth part of the touch panel display, and allowing selection of at least one of a sort mode, a stack mode, a staple mode, and a punch mode from the output document handling area (fig. 3; *the area within the Job Setup Display JSUD shown above the job feature buttons "Copy Exit" and "Staple"*).

Claims 7-8 are similar in scope to claims 1-2 respectively, and are therefore rejected under similar rationale.

Claims 13-16 are similar in scope to claim 2, and are therefore rejected under similar rationale. Wilson further teaches only information displayed in one of the touch screen panel subsections that includes selected function keys changes when the selected function keys are selected, while the display of the subsections not including the selected function keys are maintained on the touch screen panel (*all areas are depicted in figure 3*).

As per claim 17, Wilson teaches the first, second, and third touch screen panel subsections to be horizontally arranged side by side on the touch screen panel in first, second, and third touch screen panel order (fig. 3).

As per claim 18, Wilson teaches wherein the second touch screen panel subsection has a greater area than each of the first and third touch screen panel subsections (fig. 3; *control copy processing section extends from the area within the Job Setup Display JSUD shown above the job feature buttons "Original -> Copy" through "Zoom"*).

Claims 29-31 are similar in scope to claims 1-2, and are therefore rejected under similar rationale.

Claims 33-35 are similar in scope to claims 1-2, and are therefore rejected under similar rationale.

5. Claims 3-6, 9-12, 19-28, 32 and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wilson et al. ("Wilson", US 5,467,170) and Taguchi et al. ("Taguchi", US 5,937,232), in view of Kimoto et al. ("Kimoto", US 5,390,005).

As per claims 3-4, the method of Wilson and Taguchi does not disclose the steps of: displaying at least one image forming function tab, allowing selection of a program key to

register the at least one image forming function tab, displaying a programmable registered image forming function tab area on a fifth part of the touch panel display, and allowing selection of at least one registered image forming function tab. This is what Kimoto teaches in a method of indicating a setting screen of an image forming machine on which a touch-panel is displayed (col. 14, line 38 et seq.). It would have been obvious to an artisan at the time of the invention to combine Kimoto's teaching with the method of Wilson and Taguchi in order to provide a convenient and automatic condition-setting means for recalling frequently used setting for copying.

Claim 5 is similar in scope to claim 1, and is therefore rejected under similar rationale. While the method of Wilson, Taguchi and Kimoto teaches all areas are displayed on the touch panel for a selection to be made, the displayed areas are not expressly indicated to be simultaneously maintained on the touch panel display while a selection is made via the touch panel display. However, since at least the method of Wilson and Taguchi teaches a plurality of areas being displayed simultaneously when a selection is made via the touch panel display, it would have been obvious to an artisan at the time of the invention to include any number of other areas such as the programmable registered image forming function tab area to also be displayed on the touch panel display at the same time when a selection is made, in order to further facilitate users navigation and selection of functionality choices with a minimum number of screen navigation.

As per claim 6, Kimoto further teaches the step of displaying an image forming function tab to comprise display at most ten image forming function tabs (Kimoto, fig. 19).

Claims 9-12 are similar in scope to claims 3-6 respectively, and are therefore rejected under similar rationale.

Claims 19-22 are similar in scope to claim 5, and are therefore rejected under similar rationale.

Claim 23 is similar in scope to claim 6 and is therefore rejected under similar rationale.

Claims 24-28 are similar in scope to claims 4 and 6, and are therefore rejected under similar rationale.

Claim 32 is similar in scope to claim 4, and is therefore rejected under similar rationale.

Claim 36 is similar in scope to claim 4, and is therefore rejected under similar rationale.

### ***Response to Arguments***

6. Applicant's arguments with respect to claims 1 and 7 have been fully considered but they are not persuasive.

Applicant mainly argues that Taguchi neither describe or suggest an input document handling area, nor allowing selection of at least one kind of input document, and that there is no evidence that Taguchi's modes are "kinds of input documents" while there is significant evidence pointing that the modes illustrated in figure 5 are output document options.

The Examiner disagrees for the following reasons.

As pointed out in the previous Office Action, certain selection features in Taguchi's figure 5 indicate the "kinds of input documents." Examples of such features are the "CHARACTER"/"PHOTOGRAPH" and color mode selections. It seems to be logical for the operations to start with the user providing certain information about the kind of contents in an

input document, such as whether it is color or black/white, as well as text or image, so that the system can better adjust itself to optimize various internal operations such as scanning and conversion to achieve the best results for output. These types of selection features to indicate the kind of input documents are quite common in the art, where scanners and photocopiers are employed.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

### ***Inquires***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sy Luu whose telephone number is (571) 272-4064. The examiner can normally be reached on Monday - Friday from 7:300 am to 4:00 pm (EST).



If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Hong, can be reached on (571) 272-4124.

The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Sy D. Luu/  
Primary Patent Examiner  
Art Unit 2174

**Application Number****Application/Control No.**

10/822,674

**Applicant(s)/Patent under  
Reexamination**

MORIKAWA, HIROSHI

**Examiner**

Sy D. Luu

**Art Unit**

2174